



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/666,524

09/22/2003

Mikiko Hirata

Q77601

5855

23373

7590

08/24/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

SUN, SCOTT C

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,524

Applicant(s)

HIRATA ET AL.

Examiner

Scott Sun

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/30/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment to the claims filed 5/30/2006 have been noted and entered.

Response to Arguments

2. Applicant's arguments filed 5/30/2006 have been fully considered but they are not persuasive. Applicant's arguments are summarized as:
 - a. The newly amended claim 8 overcomes previous rejection under U.S.C. 101.
 - b. Prior art of record does not teach the newly added claim limitations, "a bus inputting terminal connected to the bus", and "another inputting terminal directly connected to second information processing means, wherein the second information processing means can be isolated from the bus".
3. In response to argument 'a', examiner notes that claim 8 as amended still does not recite the computer instructions as part of a statutory machine. Claim 8 merely recites that the instructions cause a functionality when executed by a computer, but does state that the instructions are stored as part of a statutory machine. The specification (page 33, lines 2-9) describes the instructions as a program that can be stored on a computer-readable recording medium (statutory) or transmitted through the Internet (non-statutory). Therefore, claim 8 is still not limited to statutory subject matter.

Art Unit: 2182

4. In response to argument 'b', examiner notes that the new limitations are features that can be found in teachings of prior art. For example, "a bus inputting terminal" can be the connector port of the 1394 bus interface (figure 22, detail shown in figure 2) and "another inputting terminal directly connected to second information processing means" can be the connection between the 1394 bus interface and the controller 12 (figure 22). More detailed analysis of the teachings is included in the rejections.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, claim 8 recites that the instructions cause a functionality when executed by a computer, but does state that the instructions are stored as part of a statutory machine. The specification (page 33, lines 2-9) describes the instructions as a program that can be stored on a computer-readable recording medium (statutory) or transmitted through the Internet (non-statutory). Therefore, claim 8 is not limited to statutory subject matter. Examiner suggests amending the claim to be directed to "a computer readable storage medium storing computer instructions ...".

7. To expedite a complete examination of the instant application, the claim(s) rejected under 35 USC 101 (nonstatutory) above are further rejected as set forth below

Art Unit: 2182

in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al (US Patent #6,477,589 B1).

10. Regarding claim 1, Suzuki discloses an information processing apparatus (devices in figure 1) connected to a single bus system (1394 serial bus) together with first information processing means (column 6, lines 41-45) comprising:

A bus inputting terminal (1394 interface port; figure 2, 22) connected to the bus;

Another inputting terminal (connection between 1394 interface and controller 12, figure 22) directly connected to second information processing means (controller 12), wherein the second information processing means can be isolated from the bus; Examiner notes that 1394 connections are not permanent (can be plugged and unplugged) and therefore the controller can be isolated from the 1394 bus.

Art Unit: 2182

A selecting device (root node, figure 18) for selectively inputting the input information (data packets) supplied from a plurality of input sources (other nodes; column 15, lines 11-24);

An acquisition device (hardware in node executing application software; column 18, lines 6-13) for acquiring first information (node information from configuration ROM; figure 9) for specifying the other information processing apparatuses connected through the bus (column 9, lines 57-62);

A setting device (hardware in node executing application software) for setting one of the first information processing means in place of the plurality of the input sources (Suzuki teaches an example of setting one of the devices as input source to printer), the input sources being for second information processing means (processed by the controller), as an alternative in the selecting device, based on the acquired first information (column 18, lines 29-63; column 31, lines 8-18).

11. Regarding claim 2, Suzuki discloses the information processing apparatus according to claim 1, further comprising:

A first notification device (communication interface of root node, figure 18b) for notifying the first information corresponding to the selected one of the first information processing apparatuses when the one of the first information processing means set as one of the alternatives is selected as the input sources;

A second notification device (communication interface of root node) for notifying the one of the input sources replaced by the currently selected one of the first

information processing means, in parallel with the notification by the first notification device (figure 18b; column 15, lines 28-35).

12. Regarding claim 3, Suzuki discloses the information processing apparatus according to claim 1, further comprising a notification device (root node) for notifying only the first information corresponding to the first information processing apparatuses supplied with the input information when the information from the first information processing means not set as the alternative is input through the bus (figure 18b).

13. Regarding claim 4, Suzuki discloses the information processing apparatus according to claim 1, wherein the setting device includes:

An extraction device for extracting (application software), based on the acquired first information, only those of the first information means meeting the conditions selectable as one of the alternative among the plurality of the first information processing means in setting one of the first information processing means as the one of the alternatives (selection of a device, figure 25; column 19, lines 25-29);
and

A display device (figure 22, display 18) for displaying only the extracted first information processing means (column 20, lines 57-65).

14. Regarding claim 5, Suzuki discloses the information processing apparatus according to claim 1, further comprising a storage device (HD 24 / RAM 16, figure 22) for storing the acquired first information (column 25, lines 32-36)

Art Unit: 2182

15. Regarding claim 6, Suzuki discloses the information processing apparatus according to claim 1, wherein the bus is a serial bus based on IEE 1394 standard (figure 1).
16. Regarding claims 7 and 8, examiner finds these claims substantially similar to claim 1. Therefore the same arguments used in rejection of claim 1 are applied.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Sun whose telephone number is (571) 272-2675. The examiner can normally be reached on M-F, 10:30am-7pm.

Art Unit: 2182

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SS

8/17/2006


TAMARA PEYTON
PRIMARY EXAMINER